

REMARKS

The Examiner is thanked for the performance of a thorough search. By this reponse, Claims 1–4, 6, 8–9, 11–12, 15–16, 38–39, 41–44, 46–47, 50–51, 53, 60, 64–67, 71–72, 77–78, 81, and 88 have been amended. Claims 17, 19–24, 26–28, 52, 54–59, 61–63, 69–70, 79–80, and 91–92 have been canceled. Claims 96–115 have been added. Hence, Claims 1–4, 6–9, 11–12, 15–16, 18, 25, 29–33, 36–39, 41–44, 46–47, 50–51, 53, 60, 64–68, 71–78, 81–90, and 93–115 are pending in this application.

All issues raised in the Office Action are addressed hereinafter.

I. CLAIM OBJECTIONS

Claims 90–95 are objected to under 37 CFR 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicants respectfully traverse the objection.

Specifically, the Office Action alleges that Claims 90–95, being directed towards an article of manufacture, are improperly dependent upon their parent method claims because Claims 90–95 may be infringed by mere possession of their recited articles of manufacture, without the methods recited in their respective parent claims necessarily being infringed.

With respect to this objection, it is recognized that it is uncommon for a dependent claim to have a different form than the claim on which it depends. However, such a practice is explicitly authorized by the MPEP. In fact, many patents have issued with this exact form of dependent claim, including:

- 6,711,567 Delivering non-default items in association with search results
- 6,661,877 System and method for providing access to a unified message store logically storing computer telephony messages
- 6,647,510 Method and apparatus for making available data that was locked by a dead transaction before rolling back the entire dead transaction

- 6,633,891 Managing replacement of data in a cache on a node based on caches of other nodes
- 6,631,371 Database fine-grained access control
- 6,130,677 Interactive computer vision system
- 6,031,934 Computer vision system for subject characterization

In all of these cases, the USPTO ultimately found the claims to be in proper dependent form. However, due to the uncommon nature of such claims, it was necessary in at least one previous case to set forth a detailed explanation of the propriety of such claims. That argument is reproduced hereafter.

Various tests have been established to determine whether a particular claim qualifies as a proper dependent claim. Significantly, none of the tests requires the dependent claim to fall within the same statutory class as the claim on which it depends. Specifically, MPEP § 608.01(n) states, among other things:

“The fact that the independent and dependent claims are in different statutory classes does not, in itself, render the latter improper. Thus, if claim 1 recites a specific product, a claim for the method of making the product of claim 1 in a particular manner would be a proper dependent claim since it could not be infringed without infringing claim 1. Similarly, if claim 1 recites a method of making a product, a claim for a product made by the method of claim 1 could be a proper dependent claim.”

TEST #1: CLAIMS 90–95 ARE PROPER UNDER 35 U.S.C. § 112

35 U.S.C. § 112 is the statutory section that sets for the requirements of a proper dependent claim. In paragraph 4, 35 U.S.C. § 112 states:

Subject to the following paragraph, a claim in dependent form shall **contain a reference to a claim previously set forth** and then **specify a further limitation of the subject matter claimed.** A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

The first sentence of this paragraph sets forth the two requirements for a proper dependent claim, and the second sentence sets forth the legal significance to the dependency.

With respect to the requirements, a proper dependent claim must (1) contain a reference to a claim previously set forth, and (2) specify a further limitation on the subject matter claimed. Both of these requirements are clearly satisfied by Claims 90–95. Specifically, each of Claims 90–95 clearly contains a reference to one of Claims 78–83. In addition, each of Claims 90–95 specifies the further limitation that instructions for performing the method of Claims 78–83 must be stored on a computer-readable storage medium, so that the method would be performed when one or more processors execute the instructions. Since Claims 78–83 do not themselves require that the method be performed by executing stored instructions, the limitations added by Claims 90–95 qualify as “further limitations.”

Because Claims 90–95 are proper dependent claims, the second sentence of 35 U.S.C. § 112, fourth paragraph indicates that it is to be construed to incorporate by reference all the limitations of the claims to which they refer. Thus, in the present case, Claims 90–95 are construed to incorporate all limitations of the methods set forth in their respective parent Claims 78–83. That interpretation of Claims 90–95 is consistent with Applicant's understanding of Claims 90–95. Specifically, to infringe Claims 90–95, a computer readable medium would have to include instructions for each and every step recited in the parent Claims 78–83.

TEST #2: CLAIMS 90–95 ARE PROPER UNDER 37 C.F.R. § 1.75(c)

37 C.F.R. § 1.75(c) states:

"One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application...."

The test set forth in 37 C.F.R. § 1.75(c) is merely an abbreviated restatement of the test set forth 35 U.S.C. § 112, fourth paragraph. As explained above, each of Claims

90–95 refers back to one of Claims 78–83, and introduces limitations that are not present in Claims 78–83. Consequently, Claims 90–95 satisfy 37 C.F.R. § 1.75(c) for the same reasons that they satisfy the 35 U.S.C. § 112, fourth paragraph test.

TEST #3: CLAIMS 90–95 ARE PROPER UNDER MPEP § 608.01(n)

MPEP § 608.01(n) states:

"the test as to whether a claim is a proper dependent claim is that it shall include every limitation of the claim from which it depends (35 U.S.C. 112, fourth paragraph) or in other words that it shall not conceivably be infringed by anything which would not also infringe the basic claim."

Unfortunately, the MPEP test involves a circular reasoning, and is therefore less useful than the tests set forth in the relevant statute and rules. Specifically, the MPEP test indicates that incorporation of all of the limitations of the base claim is what determines whether a claim is a dependent claim. However, the statute clearly dictates that, by virtue of a claim being dependent, the claim must be construed to incorporate all of the limitations of the base claim.

However, in spite of the difficulty posed by this circular reasoning, it is respectfully submitted that Claims 90–95 are also proper under the MPEP test. As mentioned above, it is fully intended that Claims 90–95 incorporate all of the limitations of Claims 78–83. In other words, to infringe Claims 90–95, a computer readable medium must include instructions for performing each and every limitation recited in Claims 78–83.

To the extent that the three tests would yield different results, it is respectfully submitted that the outcome of the test set forth in the statute should govern. However, in the present case, it is respectfully submitted that all tests yield the same results; namely, that Claims 90–95 are proper dependent claims. Thus, removal of the 37 C.F.R. § 1.75(c) objection is respectfully requested.

II. CLAIM REJECTIONS BASED ON 35 U.S.C. § 101

Claims 38, 39, 41-44, 46, 47, 50-61, 64-68, 71, 72 and 84-89 stand rejected under 35 U.S.C. § 101 as allegedly directed towards non-statutory subject matter. The Office Action alleges that the above-listed Claims are directed towards non-statutory subject matter in that they do not “specify executable instructions.” Each of the above-listed claims presently recites to a “computer-readable storage medium storing one or more sequences of instructions which, when executed by one or more processors, causes the one or more processors to perform [certain] steps.” Thus, the rejection is overcome. Applicants respectfully request removal of the rejection.

III. CLAIM REJECTIONS BASED ON 35 U.S.C. § 103

A. **Kawecki and Hosea.**

Claims 1-4, 12, 15-19, 21-24, 36, 38, 39, 47, 50-54, 56-59, 71, 73-75, 77, 78-82, 84-86, 88, 89 and 91-94 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 5,963,625 (hereinafter *Kawecki*) in view of U.S. Patent Application No. 2002/0138331 (hereinafter *Hosea*). This rejection is respectfully traversed.

CLAIM 1

Claim 1 presently recites, among other elements:

determining the identity of the service requestor based
on said requestor identifier information in said
message;
determining the identity of the service provider based on
said provider identifier information in said message;
...

identifying, based on service identifying information contained in the intercepted message, **a service that is being requested by or provided to said service requestor**;

wherein the service identifying information includes data other than said provider identifier information; and

if said message has billing implications, sending data to a billing service, the data including information related to 1) at least one of said determined identities and 2) said service.

A computer implementing the method of Claim 1 would therefore identify or determine the following items of information based on data contained in the intercepted message: 1) the identity of the service requestor; 2) the identity of the service provider; and 3) the service being provided to the service requestor. Moreover, Claim 1 recites that “service identifying information includes data other than said provider identifying information.”

For example, the intercepted message may contain a URL for content being requested by the service requestor—for instance, “http://yahoo.com/videos/latest.” The URL may comprise “provider identifier information,” such as a domain name or IP address, from which the computer implementing the method of Claim 1 may determine the identity of the service provider—for instance, “yahoo.com.” The URL may further contain a path to a file being requested from the service provider, from which path the computer implementing the method of Claim 1 may identify a service being requested by the service requestor—for instance, “/videos/latest.”

By contrast, *Kawecki* discloses a technique for intercepting telephone connection requests to 1-900 numbers. The Office Action has alleged that *Kawecki*’s 1-900 provider is a service provider within the meaning of Claim 1 and that *Kawecki*’s caller is a service requestor within the meaning of Claim 1. The Office Action has further alleged or appears to have alleged that *Kawecki* teaches the following steps: 1) determining the identity of the alleged service requestor, in that the caller’s AIN is used to identify the caller; 2) determining the identity of the service provider, in that the dialed telephone

number identifies the provider; and 3) determining the identity of the service, in that the dialed telephone number maps to a specific service provided by the provider.

Based on the Office Action's analysis, it is clear that *Kawecki* does not teach or suggest the method of Claim 1. For example, Claim 1 recites that the "service identifying information includes data other than said provider identifier information." In *Kawecki*'s invention, it would clearly be impossible to identify the specific service being requested based on anything other than the dialed telephone number. Yet, the dialed telephone number is the only information from which *Kawecki* may identify the alleged service provider. Thus, *Kawecki* features no information, other than the provider identifier information, from which a service may be identified. *Kawecki* therefore does not teach or suggest the "service identifying information" recited in Claim 1.

This distinction between *Kawecki* and the method of Claim 1 is far from trivial. For example, the method of Claim 1 allows the third party to bill a service provider or service requestor differently for each of a variety of different services hosted at a single domain or IP address. *Kawecki*, on the other hand, requires a one-to-one mapping of telephone numbers to services.

Nor would it have been obvious to modify *Kawecki* so that a telephone connection request included any information other than the dialed telephone number. While it certainly may be possible for a single telephone number to host a variety of services selected based on a user's interaction with a menu system, a telephone service provider would be unable to identify, based on the originating telephone connection request, which service had been selected.

Furthermore, it would not have been obvious to modify *Kawecki* so that *Kawecki*'s techniques were applied to an HTTP Proxy. Contrary to the Office Action's assertion, the addition of an HTTP Proxy to *Kawecki*'s technique would have constituted much more than the routine addition of an electrical device. The proposed addition of an HTTP Proxy would require numerous technical and non-obvious modifications to *Kawecki*'s system.

For example, the Internet operates in a fundamentally different manner than a telephone system. Whereas a telephone system operates over a circuit-switched network, in which callers have dedicated connections to providers, the Internet is a packet-switched network in which all communications are broken down into small packets and then transmitted over a shared connection to a recipient. While *Kawecki* may indeed have mentioned the word “Internet,” *Kawecki* suggests nothing more than that, once a circuit has been established between a caller and a provider using *Kawecki*’s techniques, the circuit may be used to transmit packets. *Kawecki*’s intercepting techniques would already have long since been completed before the caller could begin transmitting packets.

For at least the foregoing reasons, the combination of *Kawecki* and *Hosea* fails to provide the complete subject matter recited in independent Claim 1. Therefore, the combination of *Kawecki* and *Hosea* would not have rendered Claim 1 obvious under 35 U.S.C. § 103. Reconsideration is respectfully requested.

CLAIM 2

Claim 2 presently recites, among other elements:

determining that said service that **is being or has been provided** to said service requestor by said service provider through, at least in part, the intercepted message.

A computer implementing this step of Claim 2 would determine **whether a service was actually being provided, as opposed to simply being requested**, by means of the intercepted message. For example, an HTTP Proxy might implement these steps to make sure that a service requestor was only billed if the service requestor was actually provided with the service that was requested. The HTTP Proxy could determine whether or not the service was actually being provided by analyzing messages sent from the service provider in reply to a request from the service requestor.

Kawecki fails to teach or suggest any intercepted message that indicates whether or not a service is actually being provided to a service requestor. Rather, the only

intercepted message in *Kawecki* is the initial connection request from the caller. *Kawecki* does not intercept any message from the service provider—indeed, no interceptable “message” is ever sent from the provider to the caller; rather, a closed circuit is established between the caller and provider. Moreover, for this very same reason, *Kawecki* lacks the means for analyzing the contents of any communications sent from *Kawecki*’s provider to *Kawecki*’s caller, and thus would be unable to discern whether the provider was actually providing the caller with the requested service.

For at least the foregoing reasons, the combination of *Kawecki* and *Hosea* fails to provide the complete subject matter recited in independent Claim 2. Therefore, the combination of *Kawecki* and *Hosea* would not have rendered Claim 2 obvious under 35 U.S.C. § 103. Reconsideration is respectfully requested.

INDEPENDENT CLAIM 38

Independent Claim 38 also recites features argued above with relation to Claim 1, although Claim 38 is expressed in another format. Because Claim 38 has at least one of the features described above for Claim 2, Claim 38 is therefore allowable over the combination of *Kawecki* and *Hosea* for at least one of the same reasons as given above for Claim 2. Reconsideration is respectfully requested.

INDEPENDENT CLAIM 78

Claim 78 presently recites, among other elements

based at least on the identity, **determining a class of
service to which a user** associated with the identity
is entitled;
based on the class of service, **transmitting a modified
request to the provider;**

The cited references fail to teach or suggest the above-bolded steps of Claim 78 for at least the following reasons.

(1) Kawecki forwards credit scores to an AMA, but not to the provider

The Office Action alleges that *Kawecki* teaches “transmitting a modified request to the provider” because *Kawecki* at col. 11, lines 1–21 allegedly teaches that a request is passed along with credit information. The Office Action appears to be relying upon *Kawecki*’s statement that embodiments of *Kawecki*’s invention include “forwarding the [user’s credit] score itself and comparing the score with a sponsor entered required score to receive their pay service.” *Kawecki* at col. 11, lines 6–10.

The Office Action is mistaken. While *Kawecki*’s NCP 170 may indeed forward a score, *Kawecki* does not propose forwarding this score all the way to the provider 140. Rather, this score is only forwarded to back to toll switch 120, which is responsible for “comparing the caller score,” determining “if the call is allowed to proceed,” and then selecting a route to toll switch 130. *Kawecki* at col. 11, lines 8–9 and 15–16; *see Kawecki* at FIG. 1; *see also Kawecki* at FIG. 3 (depicting all of the steps that occur before a route is selected to the provider).

There is no evidence that *Kawecki* contemplates sending this score on to the provider. Nor does *Kawecki* propose modifying the connection request at all—communication between switch 120 and NCP 170 occurs behind the scenes in a manner that does not involve any modifications to the telephone call itself. *See Kawecki* at col. 10, lines 34–35 (stating that “a query is formed [by the switch 120] to the NCP 170”, evidencing that communications between NCP 170 and switch 120 are entirely tangential to the call itself).

This element is also missing from *Hosea*. In fact, the Office Action did not rely upon *Hosea* for teaching or suggesting this element.

(2) Kawecki at best, teaches to determine if a caller is a credit risk, not that the user is actually entitled to a class of service

The Office Action alleges that *Kawecki* also teaches “determining a class of service to which a user associated with the identity is entitled” in *Kawecki* at col. 11, lines 1–21. Although the Office Action fails to specifically identify what is alleged to be a “class of service,” it appears that the Office Action believes the process of classifying a

caller's credit score as "passed," "limited," or "denied" constitutes "determining a class of service to which a user associated with the identity is entitled."

The Office Action is mistaken. A credit score indicates nothing about whether or not a user is actually entitled to a class of service. At best, the credit score may indicate whether or not the user is a credit risk. The determination of whether or not someone is a credit risk is completely tangential to a determination of the class of service a user is entitled. In fact, even if the user is not a credit risk, there is no guarantee that the user is actually entitled to any class of service.

This element is also missing from *Hosea*. In fact, the Office Action did not rely upon *Hosea* for teaching or suggesting this element.

For at least the foregoing reasons, the combination of *Kawecki* and *Hosea* fails to provide the complete subject matter recited in independent Claim 78. Therefore, the combination of *Kawecki* and *Hosea* would not have rendered Claim 78 obvious under 35 U.S.C. § 103. Reconsideration is respectfully requested.

CLAIM 82

Claim 81 recites the method of Claim 78, wherein "transmitting the modified request" comprises:

based at least on the class of service, determining a
particular service to which the user is entitled;
generating a modified request for the particular service
based on the request for the first service;
transmitting the modified request for the particular service
to the provider.

Claim 82 recites the method of Claim 81, "**wherein the particular service is different than the first service.**" A computer implementing the method of Claim 82 may, for instance, receive a request from a user for a service at <http://yahoo.com/video>. The computer may determine that the user is entitled to a "gold" class of service. Based on this determination, the computer may modify the request so as to be a request for a service at <http://yahoo.com/video/gold>.

Kawecki fails to teach or suggest any such feature. *Kawecki* does not, for instance, teach or suggest that a telephone call should be forwarded to a different number depending on a class or service. For that matter, *Kawecki* does not suggest that a telephone call should be forwarded to a different number depending on a caller's credit score. As long as their calls are not denied, *Kawecki*'s callers will always be connected to the numbers they dialed, regardless of their credit scores.

The Office Action appears to believe that *Kawecki*'s mention of the NCP limiting or restricting a call constitutes a modified request for a particular service that is different than the first service. *Kawecki* does not describe how the call is limited or restricted, other than that a \$1.00 sports call may be allowed to "pass through" whereas more costly calls may not. *Kawecki* at col. 11, lines 4–6. Thus, it would appear that the mentioned restrictions or limitations only concern whether or not a call is allowed to pass through in the first place, and have no impact on the class of service obtained from a provider once the caller has been connected to the provider. Certainly, the restrictions or limitations do not suggest modifying a phone call to be for a particular service other than the service originally requested by the caller.

This element is also missing from *Hosea*. In fact, the Office Action did not rely upon *Hosea* for teaching or suggesting this element.

For at least the foregoing reasons, the combination of *Kawecki* and *Hosea* fails to provide the complete subject matter recited in independent Claim 82. Therefore, the combination of *Kawecki* and *Hosea* would not have rendered Claim 82 obvious under 35 U.S.C. § 103. Reconsideration is respectfully requested.

**CLAIMS 4, 12, 15-19, 21-24, 36, 39, 47, 50-54, 56-59, 71, 73-75, 77, 79-81, 84-86, 88,
89 AND 91-94**

Each of Claims 3, 4, 12, 15-19, 21-24, 36, 39, 47, 50-54, 56-59, 71, 73-75, 77, 79-81, 84-86, 88, 89 and 91-94 depends from Claims 1, 38, or 78, and includes the above-quoted features of its parent claim by dependency. Thus, the combination of *Kawecki* and *Hosea* also fails to teach or suggest at least one feature found in Claims 3, 4, 12, 15-19,

21-24, 36, 39, 47, 50-54, 56-59, 71, 73-75, 77, 79-81, 84-86, 88, 89 and 91-94.

Therefore, the combination of *Kawecki* and *Hosea* does not render obvious Claims 3, 4, 12, 15-19, 21-24, 36, 39, 47, 50-54, 56-59, 71, 73-75, 77, 79-81, 84-86, 88, 89 and 91-94. Reconsideration of the rejection is respectfully requested.

In addition, each of Claims 3, 4, 12, 15-19, 21-24, 36, 39, 47, 50-54, 56-59, 71, 73-75, 77, 79-81, 84-86, 88, 89 and 91-94 recites at least one feature that independently renders it patentable. However, to expedite prosecution in light of the fundamental differences already identified, further arguments for each independently patentable feature of Claims 3, 4, 12, 15-19, 21-24, 36, 39, 47, 50-54, 56-59, 71, 73-75, 77, 79-81, 84-86, 88, 89 and 91-94 are not provided at this time. Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

B. Kawecki, Hosea and Oliver.

Claims 11, 20, 31-33, 37, 46, 55, 66-68, 72, 83 and 95 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Kawecki*, *Hosea* and *Oliver* in view of U.S. Patent Application No. 2002/0133412 (hereinafter *Oliver*). The rejection is respectfully traversed.

Each of Claims 11, 20, 31-33, 37, 46, 55, 66-68, 72, 83 and 95 is dependent upon independent Claims 1, 38, or 78. As discussed in section A above, the combination of *Kawecki* and *Hosea* fails to teach or suggest one or more features of Claims 1, 38, and 78. The one or more features, identified above, which are missing from the combination of *Kawecki* and *Hosea*, are also missing from *Oliver*. In fact, the Office Action did not rely upon *Oliver* for teaching the one or more features. Consequently, the combination of *Kawecki*, *Hosea*, and *Oliver* fails to teach or suggest one or more features of Claims 11, 20, 31-33, 37, 46, 55, 66-68, 72, 83 and 95. Thus, Claims 11, 20, 31-33, 37, 46, 55, 66-68, 72, 83 and 95 are patentable over the combination of *Kawecki*, *Hosea*, and *Oliver*.

Additionally, each of the dependent claims recites at least one additional feature that independently renders it patentable over the combination of *Kawecki*, *Hosea*, and

Oliver. However, to expedite prosecution in light of the fundamental differences already identified, further arguments for each independently patentable feature of Claims 11, 20, 31-33, 37, 46, 55, 66-68, 72, 83 and 95 are not provided at this time. Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

C. Kawecki, Hosea and Malik.

Claims 6, 7, 26, 41, 42, 61, 76 and 87 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Kawecki* in view of *Hosea* and further in view of U.S. Patent No. 6,873,691 (hereinafter *Malik*). The rejection is respectfully traversed.

Each of Claims 6, 7, 26, 41, 42, 61, 76 and 87 is dependent upon independent Claims 1 or 38. As discussed in section A above, the combination of *Kawecki* and *Hosea* fails to teach or suggest one or more features of Claims 1 and 38. The one or more features, identified above, which are missing from the combination of *Kawecki* and *Hosea*, are also missing from *Malik*. In fact, the Office Action did not rely upon *Malik* for teaching the one or more features. Consequently, the combination of *Kawecki*, *Hosea*, and *Malik* fails to teach or suggest one or more features of Claims 6, 7, 26, 41, 42, 61, 76 and 87. Thus, Claims 6, 7, 26, 41, 42, 61, 76 and 87 are patentable over the combination of *Kawecki*, *Hosea*, and *Malik*.

Additionally, each of the dependent claims recites at least one additional feature that independently renders it patentable over the combination of *Kawecki*, *Hosea*, and *Malik*. However, to expedite prosecution in light of the fundamental differences already identified, further arguments for each independently patentable feature of Claims 6, 7, 26, 41, 42, 61, 76 and 87 are not provided at this time. Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

D. Kaweck, Hosea, Oliver and Manabe.

Claims 8 and 43 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Hosea* in view of *Oliver* and in further view of U.S. Patent No. 5,339,239 (hereinafter *Manabe*). The rejection is respectfully traversed.

Each of Claims 8 and 43 is dependent upon independent Claims 1 or 38. As discussed in section A above, the combination of *Kaweck* and *Hosea* fails to teach or suggest one or more features of Claims 1 and 38. The one or more features, identified above, which are missing from the combination of *Kaweck* and *Hosea*, are also missing from *Oliver* and *Manabe*. In fact, the Office Action did not rely upon *Oliver* or *Manabe* for teaching the one or more features. Consequently, the combination of *Kaweck*, *Hosea*, *Manabe*, and *Oliver* fails to teach or suggest one or more features of Claims 8 and 43. Thus, Claims 8 and 43 are patentable over the combination of *Kaweck*, *Hosea*, *Manabe*, and *Oliver*.

Additionally, each of the dependent claims recites at least one additional feature that independently renders it patentable over the combination of *Kaweck*, *Hosea*, *Manabe*, and *Oliver*. However, to expedite prosecution in light of the fundamental differences already identified, further arguments for each independently patentable feature of Claims 8 and 43 are not provided at this time. Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

E. Kaweck, Hosea, Oliver, Manabe and Hartley-Urquhart.

Claims 9 and 44 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Kaweck*, *Hosea*, *Oliver*, and *Manabe* and in further view of U.S. Patent No. 6,167,385 (*Hartley-Urquhart*). The rejection is respectfully traversed.

Each of Claims 9 and 44 is dependent upon independent Claims 1 or 38. As discussed in section A above, the combination of *Kaweck* and *Hosea* fails to teach or suggest one or more features of Claims 1 and 38. The one or more features, identified

above, which are missing from the combination of *Kawecki* and *Hosea*, are also missing from *Oliver*, *Hartley-Urquhart*, and *Manabe*. In fact, the Office Action did not rely upon *Oliver*, *Hartley-Urquhart*, or *Manabe* for teaching the one or more features.

Consequently, the combination of *Kawecki*, *Hosea*, *Manabe*, *Hartley-Urquhart*, and *Oliver* fails to teach or suggest one or more features of Claims 9 and 44. Thus, Claims 9 and 44 are patentable over the combination of *Kawecki*, *Hosea*, *Manabe*, *Hartley-Urquhart*, and *Oliver*.

Additionally, each of the dependent claims recites at least one additional feature that independently renders it patentable over the combination of *Kawecki*, *Hosea*, *Manabe*, *Hartley-Urquhart*, and *Oliver*. However, to expedite prosecution in light of the fundamental differences already identified, further arguments for each independently patentable feature of Claims 9 and 44 are not provided at this time. Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

F. Obviousness under 35 U.S.C. § 103(a): Kawecki, Hosea, and Clarke.

Claims 25 and 60 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Kawecki* in view of *Hosea* and U.S. Patent No. 5,502,636 (hereinafter *Clarke*). This rejection is respectfully traversed. The rejection is respectfully traversed.

Each of Claims 25 and 60 is dependent upon independent Claims 1 or 38. As discussed in section A above, the combination of *Kawecki* and *Hosea* fails to teach or suggest one or more features of Claims 1 and 38. The one or more features, identified above, which are missing from the combination of *Kawecki* and *Hosea*, are also missing from *Clarke*. In fact, the Office Action did not rely upon *Clarke* for teaching the one or more features. Consequently, the combination of *Kawecki*, *Hosea*, and *Clarke* fails to teach or suggest one or more features of Claims 25 and 60. Thus, Claims 25 and 60 are patentable over the combination of *Kawecki*, *Hosea*, and *Clarke*.

Additionally, each of the dependent claims recites at least one additional feature that independently renders it patentable over the combination of *Kawecki*, *Hosea*, and

Clarke. However, to expedite prosecution in light of the fundamental differences already identified, further arguments for each independently patentable feature of Claims 25 and 60 are not provided at this time. Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

G. Obviousness under 35 U.S.C. § 103(a): Kawecki, Hosea and Hahn-Carlson.

Claims 29, 30, 64 and 65 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Kawecki* in view of *Hosea* and further in view of U.S. Patent No. 6,704,612 (hereinafter *Hahn*). This rejection is respectfully traversed. The rejection is respectfully traversed.

Each of Claims 29, 30, 64 and 65 is dependent upon independent Claims 1 or 38. As discussed in section A above, the combination of *Kawecki* and *Hosea* fails to teach or suggest one or more features of Claims 1 and 38. The one or more features, identified above, which are missing from the combination of *Kawecki* and *Hosea*, are also missing from *Hahn*. In fact, the Office Action did not rely upon *Hahn* for teaching the one or more features. Consequently, the combination of *Kawecki*, *Hosea*, and *Hahn* fails to teach or suggest one or more features of Claims 29, 30, 64 and 65. Thus, Claims 29, 30, 64 and 65 are patentable over the combination of *Kawecki*, *Hosea*, and *Hahn*.

Additionally, each of the dependent claims recites at least one additional feature that independently renders it patentable over the combination of *Kawecki*, *Hosea*, and *Hahn*. However, to expedite prosecution in light of the fundamental differences already identified, further arguments for each independently patentable feature of Claims 29, 30, 64 and 65 are not provided at this time. Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

IV. ADDED CLAIMS / AMENDMENTS

The amendments to the claims were made to improve the readability and clarity of the claims and not necessarily for any reason related to patentability. The added claims and amendments to the claims do not add any new matter to this application and are supported by the Specification as originally filed. The canceled claims were canceled solely in the interest of expediting prosecution as to the remaining claims and not for any reason related to patentability.

Added claims 96–101 and 112–115 are patentable over the cited references for at least the same reasons as Claims 1, 38, and 78, upon one of which each depends.

Moreover, **Claim 96** recites that the “first participant is the service provider and the second participant is the service requestor.” In other words, Claim 96 recites that the intercepted message is a message from a service provider to the service requestor. By contrast, *Kawecki* teaches only that a message is intercepted from a caller to a provider. Clearly, *Kawecki* does not teach or suggest the method of Claim 96.

Also, **Claim 112** recites, among other elements, the method of Claim 78 wherein:

the request is addressed to a first URL for the first service;
the modified request is addressed to a second URL
associated with the class of service; and
the first URL is not identical to the second URL.

For at least the reasons discussed in conjunction with Claim 82, *Kawecki* does not teach or suggest modifying the URL to which a message is addressed based on a class of service to which a user is entitled. In fact, *Kawecki* does not even teach modifying a telephone number.

Added independent **Claim 102** is patentable over the cited references for at least the reason that none of the cited references teach or suggest “modifying said request to include information from said user profile;” and “transmitting the modified request to the provider.” *See, e.g.*, Applicants’ arguments with respect to Claim 78 in section A above.

Added claims 103–111 are patentable over the cited references for at least the same reasons as Claim 102, upon which each depends.

Each of the added claims recites at least one additional feature that independently renders it patentable over the cited references. However, to expedite prosecution in light of the fundamental differences already identified, further arguments for each independently patentable feature of the added claims are not provided at this time. Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the added claims.

V. CONCLUSION

For the reasons set forth above, all of the pending claims are now in condition for allowance. The Examiner is respectfully requested to contact the undersigned by telephone relating to any issue that would advance examination of the present application.

A petition for extension of time, to the extent necessary to make this reply timely filed, is hereby made. If any applicable fee is missing or insufficient, throughout the pendency of this application, the Commissioner is hereby authorized to any applicable fees and to credit any overpayments to our Deposit Account No. 50-1302.

Respectfully submitted,
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